

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re PATENT APPLICATION of

MURRAY

Continuation of

Group Art Unit: 2859

Application No. 09/366,781

Examiner: R. Alexander Smith

Filed: August 4, 1999

Title: RULE ASSEMBLY WITH INCREASED BLADE STANDOUT

\* \* \* \* \*

November 15, 2001

**PRELIMINARY REMARKS**

Hon. Commissioner of Patents  
Washington, D.C. 20231

Sir:

Consideration and allowance of independent claim 1 is hereby solicited.

Claim 1 is basically the same as claim 17 allowed in parent application Serial No. 09/366,781, except that it omits the limitation regarding the thickness of the blade. Claim 1 is submitted for allowance based upon the fact that to Applicant's knowledge, neither the height limitation nor the width limitation has by itself been suggested for use in a concavo-convex blade, much less the combination of these two dimensions together.

As established in the parent application, the prior art reference of Rutty applied in the parent application teaches away from the claimed blade height dimension of 0.25" - 0.40" when in the concavo-convex configuration. Rutty also does not teach the claimed width dimension. The thickness limitation in parent claim

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17 was the only limitation that is disclosed by the prior art Rutty patent and is the only limitation removed in present claim 1 in comparison with parent claim 17.

Rutty teaches a concavo-convex blade having a width of as little as  $\frac{1}{4}$  of an inch and teaches a largest blade width of only 1". This is consistent with the Applicant's understanding that, in the tape rule industry, a 1" wide concavo-convex blade was considered to be a limit of maximum desired width.

Moreover, nothing in Rutty or any other art of record suggests to increase the blade height to the levels claimed. In fact, the maximum blade height disclosed in Rutty is 0.226". The minimum claimed height of 0.25" is more than 10% greater than the height proposed by Rutty.

Rutty teaches away from increasing the blade height beyond its own disclosure. While Rutty realizes the benefits to stand out by increasing blade height in specific locations, it also recognizes that this benefit is limited because increasing blade height creates many additional problems. Specifically, Rutty states that it has been necessary to balance the advantages to be gained by increasing the depth of curvature of the blade for increased length of blade stand out with

- 1) the power requirements for the spring to effect its retraction
- 2) the life characteristics resulting from repeated deflection into the flattened condition when the blade is retracted
- 3) the difficulty in reading the indicia printed on the blade
- 4) stress points created in the blade, which may cause a stress fracture.

It is significant to note that even at the height level suggested by Rutty (i.e., 0.226"), a problem is created. Specifically, Rutty states that:

"Although the increased depth of cross section in the outer terminal section illustrated in one of the embodiments will have the effect of increasing the frictional resistance to retraction and thus augment braking action, it will be appreciated that it also increases the power requirement for retracting the extended blade if the length extended comprises only such terminal section. Thus, some manual assistance may be necessary to augment the spring force. To some extent this **problem** may be reduced by employing friction reducing rollers inside the case adjacent the exit aperture and by using a low friction synthetic resin insert to define the exit aperture as show in the illustrated embodiment." (Column 7, lines 1-13).

Thus, even at the lower concavo-convex heights contemplated by Rutty, significant problems existed. The teaching of Rutty would suggest to one skilled in the art that increasing blade height beyond its disclosure would only exacerbate such problems.

The height and width ranges claimed in claim 1 go beyond both the width and height dimensions known in the art for concavo-convex blades by 10% or more. As established during prosecution of the parent application, increasing the height dimension by this amount, or increasing the width dimension by this amount, were each individually considered to be problematic in the art.

While the range of thickness claimed in the parent application was significant since it had some bearing on the droopiness of the blade, it is not required for patentably defining a clearly non-obvious structural configuration.

It should be noted that the totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness.

In re Hedges, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). This is exactly the

situation here. The very general statements found in Rutty in no way suggest to the skilled artisan to go outside its teachings and try new height and width dimension combinations. It should also be noted that general statements that are not at all specific as to the particular form of the claimed invention and how to achieve it do not render an invention obvious. See, Ex parte Obukowicz, 27 USPQ2d 1063 (BPAI 1992); See, Transpac Drilling Venture v. U.S., 16 F.3d 383 (Fed. Cir. 1994). Finally, the Examiner is also directed to the Rule 132 Declaration submitted in the parent application, which establishes the commercial success of the "FAT MAX" product.

It is submitted that claim 1 is clearly patentable over the prior art. An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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